

REMARKS

A. Introduction

Claims 1-26 are pending and under consideration in the application.

In the Office Action of September 9, 2009 ("the Office Action"), claims 1-26 were rejected as obvious.

In response, the rejections are traversed.

Reconsideration and allowance of all the pending claims are requested in view of the following remarks.

B. Rejection under 35 USC §103

Claims 1, and 3-26 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent Publication 2003/0044719 to Katoh in view of U.S. Patent Publication 2003/0161988 to Hwang. Applicants traverse these rejections for at least the following reasons.

1. Independent Claim 1

Independent claim 1 recites, *inter alia*, "the lower dielectrics layer includes a first lower dielectrics layer and a second lower dielectrics layer that inhibits a material that constitutes the first lower dielectrics layer and a material that constitutes the reflective layer from reacting; and the upper dielectrics layer includes a first upper dielectrics layer and a second upper dielectrics layer that inhibits a material that constitutes the first upper dielectrics layer and a material that constitutes the light transmissive layer from reacting," i.e., four (4) dielectric layers.

In the prior office action of March 13, 2009 ("the Non Final OA"), the Examiner attempted to meet this recitation by arguing Katoh teaches "a lower dielectrics layer (2)" and "an upper dielectrics layer (4)." See the Non-Final OA, para. 5. Thus, the Non-Final OA only addressed 2 of the 4 dielectrics layers required by independent claim 1, and the rejection was fatally flawed.

In response, Applicant pointed out the flawed rejection. The Examiner was apparently persuaded because the Examiner now argues that the secondary reference, Hwang, "teaches four dielectric layers on para [0016]." See the Office Action, para. 1. However, the rejection is flawed for at least five (5) reasons.

First, Hwang is limited to dielectric layers 12/14/16/18 that are each separated by a

layer, i.e., a recording layer 13, a separation layer 15, and a recording layer 17. Because Hwang separates each of the Hwang dielectrics layers with a non-dielectric layer, Hwang fails to disclose two dielectrics layers that each "include[] a first upper dielectrics layer and a second upper dielectrics layer," as recited by independent claim 1.

Second, the Hwang dielectric layers 12/14/16/18 do not coordinate to inhibit reaction with other layers and, therefore, fail to provide: (1) "a second lower dielectrics layer that inhibits a material that constitutes the first lower dielectrics layer and a material that constitutes the reflective layer from reacting;" and "a second upper dielectrics layer that inhibits a material that constitutes the first upper dielectrics layer and a material that constitutes the light transmissive layer from reacting," as recited by independent claim 1.

Third, the motivation to extract the Hwang dielectrics layers for incorporation into Katoh is flawed because the Examiner does not provide any motivation for such. In the instance the Examiner is relying on motivation previously provided, the only motivation provided relates to the Hwang light transmissive layer, an element completely separate from the Hwang dielectric layers. Clearly, one would not be motivated to incorporate the Hwang dielectric layers in view of motivation to incorporate the Hwang light transmissive layer.

Fourth, Hwang fails to provide any benefits or other motivation to incorporate the Hwang dielectrics layers into Katoh. Thus, one having the benefit of Hwang would not be motivated to extract the Hwang dielectrics layers for incorporation into Katoh. At best, the Examiner seems to be using impermissible hindsight.

When applying 35 U.S.C. 103, the following tenets of patent law must be adhered to:

- (A) The claimed invention must be considered as a whole;
- (B) The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination;
- (C) The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and
- (D) Reasonable expectation of success is the standard with which obviousness is determined.

Hodosh v. Block Drug Co., Inc., 786 F.2d 1136, 1143 n.5, 229 USPQ 182, 187 n.5 (Fed. Cir. 1986). (Emphasis added).

Fifth, the Examiner materially altered the rejection of independent claim 1 by: (1) agreeing that Katoh does not disclose recited layers and is further deficient, as pointed out by

Applicant; (2) retracting the argument that Katoh discloses the recited layers; and (3) arguing that Hwang discloses the recited layers and remedies the Katoh deficiency. However, the Examiner improperly attempts to alter the rejection in the Examiner's "Response to Arguments" while leaving the actual rejection unaltered. Thus, the rejection of independent claim 1 remains flawed for the reasons pointed out by Applicant in response to the Non-Final OA.

2. Independent Claim 14

Independent claim 14 recites, *inter alia*, "forming the reflective layer on one main surface of a substrate; a first lower dielectrics layer and a second lower dielectrics layer that inhibits a material that constitutes the first lower dielectrics layer and a material that constitutes the reflective layer from reacting, and thereby forming the lower dielectrics layer; forming the recording layer on the lower dielectrics layer; a first upper dielectrics layer and a second upper dielectrics layer that inhibits a material that constitutes the first upper dielectrics layer and a material that constitutes the light transmissive layer from reacting, and thereby forming the upper dielectrics layer."

Similar to the above, in the Non Final OA, the Examiner attempted to meet this recitation by arguing Katoh teaches "a lower dielectrics layer (2)" and "an upper dielectrics layer (4)." See the Non-Final OA, para. 5. Thus, the Non-Final OA only addressed 2 of the 4 dielectrics layers required by independent claim 1, and the rejection was fatally flawed.

In response, Applicant pointed out the flawed rejection. The Examiner was apparently persuaded because the Examiner now argues that the secondary reference, Hwang, "teaches four dielectric layers on para [0016]." See the Office Action, para. 1. However, the rejection is flawed for at least four (4) reasons.

First, the Hwang dielectric layers 12/14/16/18 do not coordinate to inhibit reaction with other layers and, therefore, fail to specifically provide: (1) a second lower dielectrics layer that inhibits a material that constitutes the first lower dielectrics layer and a material that constitutes the reflective layer from reacting;" and (2) a second upper dielectrics layer that inhibits a material that constitutes the first upper dielectrics layer and a material that constitutes the light transmissive layer from reacting," as recited by independent claim 14.

Second, the motivation to extract the Hwang dielectrics layers for incorporation into Katoh is flawed because the Examiner does not provide any motivation for such. In the

instance the Examiner is relying on motivation previously provided, the only motivation provided relates to the Hwang light transmissive layer, an element completely separate from the Hwang dielectric layers. Clearly, one would not be motivated to incorporate the Hwang dielectric layers in view of motivation to incorporate the Hwang light transmissive layer.

Third, Hwang fails to provide any benefits or other motivation to incorporate the Hwang dielectrics layers into Katoh. Thus, one having the benefit of Hwang would not be motivated to extract the Hwang dielectrics layers for incorporation into Katoh. At best, the Examiner seems to be using impermissible hindsight.

When applying 35 U.S.C. 103, the following tenets of patent law must be adhered to:

- (A) The claimed invention must be considered as a whole;
- (B) The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination;
- (C) The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and
- (D) Reasonable expectation of success is the standard with which obviousness is determined.

Hodosh v. Block Drug Co., Inc., 786 F.2d 1136, 1143 n.5, 229 USPQ 182, 187 n.5 (Fed. Cir. 1986). (Emphasis added).

Fourth, the Examiner materially altered the rejection of independent claim 14 by: (1) agreeing that Hwang is further deficient, as pointed out by Applicant; (2) retracting the argument that Katoh discloses the recited layers; and (3) arguing that Hwang discloses the recited layers and remedies the Katoh deficiency. However, the Examiner improperly attempts to alter the rejection in the Examiner's "Response to Arguments" while leaving the actual rejection unaltered. Thus, the rejection of independent claim 14 remains flawed for the reasons pointed out by Applicant in response to the Non-Final OA.

Accordingly, Hwang and Katoh, both individually and combination, fail meet all of the limitations recited in independent claims 1 and 14. Therefore, the rejections of these claims as well as claims depending from these claims are improper, and withdrawal of these rejections and allowance of these claims are earnestly solicited.

C. Finality

The finality of the Office Action is premature because the Examiner's grounds for rejection were changed (because the Examiner: (1) agreed that Hwang is further deficient, as

pointed out by Applicant; (2) retracted the argument that Katoh discloses the recited layers; and (3) now argues that Katoh remedies Hwang's further deficiency), and the claims were not amended.

Further, finality of the Office Action is premature because the Examiner disregarded all of Applicant's arguments submitted in Applicant's response to the Non-Final OA.

In sum, Applicant pointed out that the Examiner repeatedly employs Katoh to reject the majority of dependent claims, but fails to provide any motivation to incorporate the Katoh elements into the primary reference, Hwang. For instance, in attempt to reject claims 5 and 18, the Examiner alleges Katoh employs a "phase change recording layer." See the Office Action, page 4. Further, the Examiner alleges that Katoh teaches specific material percentages and thicknesses in attempt to reject other claims. Still further, in attempt to reject claims 11 and 24, the Examiner alleges that Katoh a light transmissive sheet and an adhesive layer. Notably, the Examiner provides no logic or other articulated reasoning as to why one would be motivated to employ this Katoh element into the primary reference, Hwang. Thus, these rejections under U.S.C. 103 are flawed.

The MPEP states "[t]he examiner should never lose sight of the fact that in every case the applicant is entitled to a full and fair hearing" and "any such grounds relied on...must be clearly developed to such an extent that applicant may readily judge the advisability of an appeal." See MPEP §706.07. In view of the fact that the Examiner has not addressed all of Applicant's arguments, Applicant is unable to readily judge the advisability of an appeal.

Accordingly, Applicant requests withdrawal of finality, and in the instance the rejections are maintained, Applicant also requests that the Examiner address all of Applicant's arguments.

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Amdt. Dated: December 8, 2009
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D. Conclusion

In view of the foregoing, it is submitted that claims 1-26 are allowable and that the application is in condition for allowance. Notice to that effect is requested.

If any further fees are required in connection with the filing of this amendment, please charge the same to our Deposit Account No. 19-3140.

Respectfully submitted,
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